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IN THE  
United States 3  
**Circuit Court of Appeals,**  
FOR THE NINTH CIRCUIT.

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Charles Henry Pray,

*Appellant,*

*vs.*

W. B. Copes and J. E. Hill, Doing  
Business Under the Fictitious Name  
of Triangle Iron Works; and M. J.  
Fitzgerald and W. A. Samson, Do-  
ing Business Under the Fictitious  
Name of National Fire Escape Lad-  
der Company,

*Appellees.*

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**APPELLANT'S REPLY BRIEF.**

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RAYMOND IVES BLAKESLEE,  
J. CALVIN BROWN,  
*Solicitors and Counsel for Appellant.*

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**STATEMENT.**

Permission having been granted to plaintiff-appellant by this Honorable Court to file a reply brief, certain questions and points raised in appellees' brief will be briefly discussed and likewise certain inadvertent errors that appear in appellant's opening brief will be corrected. Attention is first directed to corrections necessary in appellant's opening brief.

*Corrections:*

Page 4, fourth and fifth lines from the bottom read:

“On the 19th day of February, 1923, the court denied such petition to vacate the interlocutory decree as”.

This should read:

“On the 19th day of February, 1923, the court denied plaintiff’s petition to re-hear defendants’ petition to vacate interlocutory decree as”.

Page 21, assignment of error X, the date instead of being “July 13, 1923”, should read “April 8, 1922”. The transcript is also in error as to this. [See Tr. p. 94.] Appellant’s opening brief, page 13, states the date correctly.

We also note on page 39 of appellant’s opening brief quotation marks, fourth line from the bottom of the page, which obviously should not be present.

Page 43, it was stated, last paragraph:

“Mr. Harpham apparently, despite his experience, was unable to find in the prior art any patents or publications which he could introduce upon the retrial of the cause to anticipate or otherwise limit the patent in suit, and the record of this case shows that there was no prior art of any kind introduced into evidence for any purpose whatsoever.”

What really happened appears on page 82 of the transcript, and what should have been said was that *no prior patent was offered in evidence as pleaded*.

It will be noted upon reference to Tr. p. 82 that objection was made to the introduction of the Pauly patent except to show the state of the prior art, for the reason that such patent was not a certified copy

as required by Sec. 892 of the Revised Statutes of the United States. The court admitted the *uncertified* copy, apparently to show the state of the art, and this admission of an uncertified copy was similarly objectionable. We know of no equity rule that requires an exception to be noted to this ruling of the court. At the time the brief was written, counsel for plaintiff-appellant did not have before them the transcript of the testimony, and upon enquiring of the clerk of the District Court just what exhibits had been transmitted to this Honorable Court was informed that there were no exhibits on the part of defendants-appellees, and due to the lapse of time since the case was tried on re-hearing, counsel had completely forgotten the fact that the Pauly patent was introduced to show the state of the art.

### Pauly Patent.

It is not believed that defendants-appellees would claim that a structure made in accordance with the Pauly patent teaching infringes the Pray patent, even assuming that the Pray patent was first in point of time, nor is it believed that defendants-appellees would contend that a structure made in accordance with the Pray patent is an infringement of the Pauly patent, for if they did or had so believed this to be, it is very likely that they would have inserted a counter-claim as against plaintiff-appellant instead of alleging that they manufactured under this patent, as they did in their answer, allegation VI, Tr. p. 52. The general rule, as has been repeatedly annunciated in

numerous decisions, is that *that which anticipates if earlier would infringe if later*, and when this rule is applied and the Pauly patent is duly considered, with relation to the structure therein described, the difference between it and the structure of Pray will be readily appreciated. We shall describe the differences between the structures, but before setting forth such differences we desire to call the court's attention to the fact that the Pauly patent is not properly before this court, for the reason that counsel for defendants-appellees at no time attempted to describe the Pauly patent, nor show that the fire escape manufactured by them was made in accordance with such Pauly patent. An inspection of the transcript of the testimony will show this to be true, and certainly counsel's brief on behalf of defendants-appellees, Copes and Hill, at pages 18 and 19, does not point out the distinction between their structure and the Pray patent structure, but rather attempts by innuendo to state that the Pauly patent device and the Pray patent device are for one and the same thing. However, defendants-appellees cannot argue at this time that the Pauly patent structure anticipates the Pray structure, for the very reason that the Pauly structure was not set forth or introduced into evidence as an anticipatory structure, and cannot be considered by the court as such; and furthermore, prior art patents *not so pleaded are not admissible as anticipations*, as see *Sodemann Heat & Power Co. v. Kauffmann*, 275 F. 593. (Decree 267 F. R. 435 reversed) (C. C. A. 8th Cir. 1921.)

“Prior patents, not pleaded, and of which notice has not been given as required by Rev. St. Sec. 4920, as amended (Comp. St. Sec. 9466), while they may be admitted as showing the prior art, in aid of the construction of a claim, are not admissible as anticipations, or to invalidate the claim for want of novelty. Where, under the present equity rules, evidence must be taken in open court, this requirement of notice should be strictly enforced.”

In addition to this, uncertified copies of patents are not evidence, as see the case of *National Cash Register v. Gratigny*, C. C. A. Sixth Circuit, 213 Federal Rep. 463, 467, in which the court said:

“[4, 5] The patent copies, being uncertified, were not legally admissible.”

and as we have previously pointed out, we know of no equity rule that requires us to note exception to the court's allowing the uncertified copy of the Pauly patent to be introduced into evidence.

As to the Pauly patent, a brief analysis will show its entire want of anticipatory character, even had it been so pleaded. The Pauly patent fails to show any fixed ladder between balconies with which a ground ladder is combined or by which it is guided. It shows a pair of spaced guideways, 18 (without rungs), vertically movable bars 22 guided therein (without rungs), stairs 24 connected to the lower portion of the bars 22 by links 28; the upper ends of the side members of the stairs 24 having rollers 30 guided by the guides 31 on the spaced bars 22; hand rails 27 pivoted to links

29, in turn pivoted to the stairs 24 and having rollers 32 guided by the guides 31. The stairs 24 are supported by ropes or cables 36 branched at 38 as shown in Figure 5, the cables in turn being connected to the counterbalance weight 33. It will be noticed that there is *no fixed ladder* with rungs between balconies or connected at a side of the balcony railing in this device. The bars 22 do not even extend from balcony to balcony. In operation, as set forth in claim 1, for instance, as the stairway 24 is raised the links 28 and 29 permit the hand rails 27 and stairs to swing in parallel with the guideways 18 and spaced bars 22. When this operation is completed, stairs, hand rails and bars 22, all in parallel relation, move upwardly guided by the guideways 18. On reversal, the parts are lowered and the stairway swings out into inclined position with its hand rails as shown in Figure 6. A latch device 42 cooperates with a projection 43 on the guideways 18 when the swinging stairway and hand rails are elevated. Now, in the first place, *this device has absolutely no fixed ladder between balconies guiding a vertically slidable ground ladder, so one element of the Pray patent claims is entirely missing.* This alone avoids any possible anticipation. In the second place, *the entire mode of operation is varied by providing in the combination a ladder and hand rails that swing and collapse, in addition to sliding. The combined fixed ladder with rungs and sliding ladder guided by it, which are elements of the Pray claims, are entirely lacking in this device.*



It will be seen that the Pauly device is for an entirely different structure than that of the Pray patented device. The mode of operation is different, and defendants-appellees, we contend, have *copied* the Pray patented structure, *impairing the function* of certain elements thereof, namely, the fixed ladder structure, for the simple reason that a fixed stairway is oftentimes placed between balconies, and for this reason it would be unnecessary to put in all the rungs of the fixed ladder between the balconies. The fact remains, however, that defendants-appellees do provide a fixed ladder. True, certain of the rungs are missing, but this does not avoid infringement. In part of the fixed ladder they are fully present and can be used and are intended to be used for scaling purposes. Counsel for defendants-appellees in his brief, page 9, says:

“Reference to the slidable or movable ladder shows that it is only slightly over ten feet long, while it is stated that the bottom of the balcony is more than twelve feet from the ground. It is obvious from the drawing that there is *a short permanent ladder* extending three or four feet below the top rail of the lower balcony, and that when the slidable ladder is lowered its length, added to the length of this short ladder, provides a continuous ladder extending from the first balcony to the ground.” (Italics ours.)

It will be seen that counsel admits that they have “*a short permanent ladder.*” This so-called short permanent ladder consists of two stringers extending between two balconies, with quite a number of rungs joined thereto, and ranging downwardly from the lower balcony railing top. It is admitted, as counsel

for defendants-appellees would have us believe, that a person should climb over the first balcony railing and step upon these rungs of the fixed ladder in order to reach the rungs of the movable ladder when the movable ladder is in its lowered position. Counsel in his argument before this Honorable Court on Wednesday the 8th of October, stated apparently referring to the Times installation, that the distance between the balconies was fourteen feet and that the distance from the first balcony to the ground was twelve feet. If this is true, then it would not be necessary, we contend, for defendants-appellees to manufacture a *short* movable ladder as they could manufacture a movable ladder fourteen feet or more long *and avoid the necessity of having a permanent ladder*. However, the defendants-appellees did not choose to do so, but preferred to follow the Pray patented teaching and structure, that is, providing a fixed ladder and a movable ladder slidable in conjunction therewith. The case of *Renfield v. Chambers*, 92 Fed. R. 630, is directly in point, in which the court said:

“We think O’Brien’s structure comes within the settled rule that infringement is not avoided by impairment in degree so long as the function is retained.”

And this Honorable Court has also enunciated the same doctrine in the case of *Stebler v. Riverside Heights Orange Growers’ Association*, 205 Fed. R. 735. (See excerpt from this case in plaintiff’s opening brief, page 40.)

Upon the question of infringement the claimed structure itself is to be looked to and not the results obtained, except as they may go to the question of identity, and infringement is not avoided because the patented device is not utilized to the full extent possible nor because a feature is retained which might be dispensed with to advantage and which it was one of the purposes of the patented device to render unnecessary. —(C. C. 1906) *Wills v. Scranton Cold Storage Co.*, 147 F. 525, decree affirmed; *Same v. Scranton Cold Storage & Warehouse Co.* (C. C. A. 1907), 153 F. 181, 82 C. C. A. 355.

To the same effect, see:

*Kawneer Mfg. Co. v. Toledo Plate & Window Glass Co.*, 232 F. 362, judgment affirmed, 237 Fed. 364; and

*Kawneer Mfg. Co. v. Detroit Show Case Co.*, 240 Fed. 737.

The patent law does not permit one claiming a ladder *as such*, to have his monopoly tampered with by a person leaving out one or more rungs *and particularly in a structure that can be easily and usefully employed as a ladder throughout part of its length or have rungs added*. From the top of the ground ladder when lowered, occupants of the Times Building or fireman handling hose, *would have to use the lower portion of the fixed ladder as a ladder in climbing down or up over the railing to the lower balcony*. Whether the ladder be so equipped that all the rest of its length can be conveniently employed for climbing or handling hose, etc., is a matter of choice and preference. In

the case of *Wilson v. Union Tool Co.*, 237 Fed. 847 (affirmed by Your Honors in 249 Fed. 736), Judge Cushman well said in handling a fallacious issue of this sort raised by defendant (p. 854):

“The fact that defendant did not appropriate the perhaps relatively more important conception of *Wilson*, whereby the cutter shanks were allowed to collapse between the prongs, does not excuse it or take from the infringement it has practiced, for the seat or bearing of a cutter head on these faces or lugs, is not dependent upon the swing in collapse of the cutter shanks between the prongs.”

To use the invention of the patent for any purpose, to any extent, is an infringement and we have frequently so argued before this court. As said in *Acme Truck & Tool Co. v. Meredith*, 183 F. 124:

“A patentee who has sufficiently described and distinctly claimed his invention is entitled to every use to which his device can be applied, whether he perceived or was aware of all such uses at the time he secured his patent or not.”

Walker on Patents, end of Section 346, Fourth Edition, page 304, says:

“Harmoniously with its decision in *Burr v. Duryee*, the Supreme Court has since had a positive tendency to disregard whatever is abstract and intangible in questions of infringement, and to base its conclusions upon the concrete features of the issues at bar.”

This court certainly will not permit a defendant *to adopt* the whole combination of a patented invention, *with its identical mode of operation*, and merely vary

the number of rungs in a ladder entering into that combination, for it is immaterial from the standpoint of infringement, whether the manufacturers or the users take out or put in one or more rungs in what is obviously a ladder and usable as such, *and admitted to be such.*

### Consideration of Certain Points Raised in Defendants-Appellees Brief.

Taking up appellee's brief further, on page 7 something is said about the first answers to the interrogatories not being offered or received in evidence at the second trial. This may be true, *but the whole proceeding leading to the granting of the re-trial was based upon an alleged mistake of defendants in swearing to these answers as they did.* Surely the defendants cannot equitably and honestly attempt to withhold these first alleged erroneous answers from the scrutiny of this court, when they refer to them themselves in their brief as they do, pages 14 and 15. They have argued these first alleged erroneous answers right into the case [Tr. p. 81]. Furthermore, plaintiff's counsel on the trial very carefully offered all the "proofs, proceedings and interrogatories," on the second trial, although the original answers were understood to be excluded from evidence. But certainly this court on a review of the entire matter, and in the light of the distinct reference to the same made by defendants in their brief, as above noted, will needs consider those first answers. Among our assignments or error appears the assignment X [Tr. 94], "That said court erred in

setting aside the answers to interrogatories filed July 13, 1923," which as we have seen should read "April 8, 1922." This is a part of the *res gestae* (See Jones on Evidence, civil edition), and it is an essential and vital part particularly with respect to that equitable phase of the case pertaining to clean hands. The assignment of error XVII [Tr. 96] deals with the unclean hands of defendants on rehearing. Assignments XI and XII deal with the error in setting aside the first decree and in granting a rehearing. These assignments are sufficiently broad to bring in this whole question of the first answers to the interrogatories. Infringement in this case is made out by an inspection of the photographs of the Times structure admittedly made by defendants as per stipulation [Tr. 69, 70]. But infringement is further established and admitted by these first interrogatory answers in which the rungs of the fixed ladder are marked as rungs.

On page 7 of appellees' brief, something further is said about the first interrogatory answers. In this connection, as to the propriety of the courts considering this part of the *res gestae* we call attention to Your Honors' consideration of a mere affidavit of one Thorne filed with the petition for rehearing in the case. *Willard et al v. Union Tool Co.*, 253 Fed. R. 48, at page 52.

The whole attempt of appellees' counsel on pages 12 and 13 of their brief to make it appear that defendants only have two stringers spaced apart with stiffeners to prevent distortion, when these stringers are the side rails of a real ladder, is so absurd that we cannot under-

stand how the trial court could find non-infringement, particularly in view of these first interrogatory answers, and the obvious facts already set forth that the fixed device is certainly materially usable as a ladder without the addition of any further rungs.

The only reason that the ordinance of the city of Los Angeles was referred to (page 14 of appellant's brief), is that this ordinance was read to the court on the argument of the motion for rehearing. It does not make any difference one way or another whether it be considered or not. It simply assists in showing the unclean hands of defendants who filed the same blue prints with the city of Los Angeles in obtaining permission to do business as they attached to their first interrogatory answers.

On page 16 of appellees' brief a contradiction is given by appellees to the photograph they introduced on their petition for rehearing. They have admitted making the Times structure, which is obviously very different from the structure of their photographs.

The authorities referred to on pages 20 and 21 of appellees' brief are not at all in point. Every one of the elements of the Pray patent claims *as such* appear in defendants' device.

In this case infringement is not only proven but admitted. The defendants were men skilled in the art and they swore to the first interrogatory answers admitting infringement *knowingly and openly*, and simply used the method of changing counsel in order to make it appear that they were in error. If defendants are not believed under oath and are permitted to

change their proofs as to facts, directly before them, and nailed fast to the record by documentary evidence such as blue prints, there would never be an end to any litigation. The chicanery of defendants is shown by the very significant difference between the showing of the photographs attached to their petition for rehearing and the showing of the photographs of the structure they have admitted they installed upon the Times Building.

In what shall we believe the appellees? Shall we believe their first interrogatory answers, or shall we believe them when they say the Times structure is theirs and it disagrees with the structure of their own photographs? They said the blue prints attached to their corrected first interrogatory answers were correct, and these show a fixed ladder and the rungs are marked "rungs."

The authority we cite in our opening brief at page 26, 249 Fed. 729, was a rule laid down in a case decided for defendant. But we cited it without hesitancy inasmuch as it thoroughly fits the present case.

The McKeag affidavit should be considered on the question of unclean hands of defendants. It got into the case on the rehearing matter, and is part of the *res gestae* and very significant, as we say, on the question of unclean hands of defendants.

### **The Testimony of Mr. Copes Upon Re-hearing is Contradictory.**

Mr. Copes upon direct examination testified as follows [Tr. pp. 84, 85]:



“Q. Have you ever manufactured any fire escapes comprising ‘two relatively spaced stationary platforms and an intermediate stationary vertical ladder, a slidable ground ladder, means for retaining said ground ladder in close sliding engagement with the stationary ladder, counter-balance means connected to the ground ladder and manually operated means normally supporting the ground ladder in elevated position’?”

A. No, sir.”

And upon cross-examination [Tr. pp. 86 and 87], the testimony was as follows:

“Q. (By Mr. Brown.) What did you manufacture of the structures shown in the drawing?”

A. A slidable ground ladder.

Q. And that is marked how?

A. That is marked A.

Q. And what else?

A. The frame that is marked B here to support the guides.

Q. And where did you place that frame?

A. That was placed from the second to the third floor.

Q. And its purpose was what?

A. For a guide for the sliding ladder A.

Q. Are there any rungs on that frame between the second and third balconies?

A. Only such rungs, or you might call them rungs, as are put in there for braces.

Q. And the rungs at the bottom of the frame, what are they for, referring to the second photograph?

A. They were prepared to go from the bottom balcony down.

Q. Were they attached to the frame?

A. Yes, sir.

Q. What else did you manufacture of that structure?

A. Well, the counter-balance.

Q. That includes the cable and the balance, does it?  
(69)

A. Yes, sir.

Q. And do you have sheaves in the structure?

A. Yes, sir.

Q. Where are they?

A. They are at the top of the frame B.

Q. Did you hold the ladder in elevated position, the movable ladder?

A. Yes, sir, with a locking bar up in the center of the frame. It wasn't in the bottom of the groove.

Q. And it engaged the movable ladder, did it?

A. Yes, sir.

Q. And held it in elevated position?

A. Yes, sir.

Q. And did the movable ladder slide upon the frames or was it guided by the frames in its movement?

A. There were clips on the frame.

Q. And it guided the movable ladder?

A. Yes.

Mr. Brown: That is all."

It will be noted that the device that Mr. Copes stated upon direct examination that he *did not manufacture* was the very device that he admitted that *he did manufacture*, upon cross-examination. Yet, the defendants-appellees upon the rehearing wished the court to believe, *First*, that their first interrogatory answers, Plaintiff's Exhibits 3 and 4, at the first hearing, *were incorrect*; *Second*, that the *blue print* attached to such interrogatory answers on first hearing *showed their structure* but that we did not read it correctly; *Third*, that they only manufactured *one form* of ladder and

that was *in accordance with their photographs attached to their notice of motion, and motion to vacate interlocutory decree* [Tr. p. 24]; *Fourth*, that the stipulated structure shown by the Times photographs was a true representation of what was manufactured by them, and yet they attempt to reconcile their contradictory statements by attempting to assert that they did not have a permanent ladder with a movable ladder, slidable in conjunction therewith, and yet admit in their brief, page 9, that they had a short fixed ladder, with further admissions as to what they manufactured when cross-examined on rehearing [Tr. pp. 86, 87 *supra*.]

### The Testimony of Mr. Samson on Re-hearing.

Mr. Harpham asked Mr. Samson the following question [Tr. p. 88]:

“Q. Have you ever sold or made or used any fire escape structures which had a second and third floor platform and a *permanent ladder extending from the one platform to the other?*”

A. I have, yes, sir. I have sold them. I never manufactured them but I have had them manufactured.” (Italics ours.)

This is further admission as to what the defendants-appellees were actually doing.

We do not believe that this Honorable Court will allow the defendants-appellees to escape the consequences of their infringing acts, and this court has said in the case of *Central California Canneries Co. v. Dunkley*, 247 Fed. 791, at 793:

“If Campbell’s testimony was not true, he was testifying falsely concerning a material and relevant matter, and his testimony would for that reason be wholly rejected. *‘Falsus in uno, falsus in omnibus.’*” (Italics ours.)

This court cannot believe the defendants-appellees because of their contradictory statements. But their many admissions are binding upon them. The fact that the defendants-appellees asked to be relieved from infringement (when and because they told the truth by their first interrogatory answers, Plaintiff’s Exhibits 3 and 4, first hearing), should be particularly significant.

Reversal is again solicited.

Respectfully submitted,  
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J. CALVIN BROWN,  
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